

Application No. 10/800,989
Docket No. 2003-0586.01
(58814.US/4665.0)

REMARKS

Claims 1-16 are in the application. In the Office Action, a restriction requirement was made between claims 1-10 (Group I claims), drawn to a micro-fluid ejection device in class 347, subclass 47, and claims 11-16 (Group II claims) drawn to a method for making a printhead in class 29, subclass 890.1. In response to the restriction requirement, applicants hereby elect the Group I claims (claims 1-10). This election is made solely for the purpose of advancing prosecution in the case and is made with traverse.

Applicants respectfully submit that the requirement to restrict the claims made in this case is improper. The claims as grouped by the examiner are sufficiently related that their respective classes and subclasses would be thoroughly cross-referenced, and essentially the same classes and subclasses would have to be reviewed regardless of which group was examined.

When searching the Group I claims for prior art relating a micro-fluid ejection head having an overlapping nozzle plate structure to protect leads and bonds pads to a chip, the examiner will undoubtedly have to search art related to a method for making a printhead having a bond pad protective structure as provided in the Group II claims. Likewise, when searching the Group II claims for subject matter directed to a method for making a printhead having a bond pad protective structure, the examiner will have to search art relating to micro-fluid ejection heads having an overlapping nozzle plate structure to protect leads and bond pads called for in the Group I claims.

It is therefore evident that examination of the Group I, and Group II claims in separate applications will result in duplication of effort since the same classes and subclasses should be searched regardless of which claims are elected. Such duplication of effort is wasteful of Patent Office manpower and resources and it also needlessly increases the cost to the public in obtaining patent protection for closely related inventions or for applications which contain claims of overlapping scope.

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Moreover, restriction is not "required" by 35 U.S.C. § 121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). The MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).


The Examiner has not shown any serious burden if examination of all of the claims is conducted at one time. Applicants therefore urge the examiner to reconsider this matter, withdraw the restriction requirement, and proceed with examination of Claims 1-16 in this application.

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension, along with any other fees which may be due with respect to this paper, be charged to our Deposit Account No. 12 2355.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM P. C.

By:

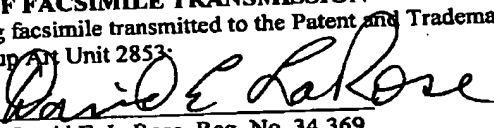

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office at 703-872-9306, ATTN: Examiner A.H. Do, Group Art Unit 2853.

on June 16, 2005


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